Supreme Court, U.S.
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No. 01-368

In The

Supreme Court of the United States

GARY SADERUP, an individual, and
GARY SADERUP, INC., a California corporation,

Petitioners,

v.

COMEDY III PRODUCTIONS, INC.,
a California corporation,

Respondent.

On Petition For A Writ Of Certiorari To The Supreme Court Of California

REPLY TO BRIEF IN OPPOSITION

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REPLY TO BRIEF IN OPPOSITION

1. *The Downing Case.* Respondents' only attempt to deny that the California Supreme Court's decision in this case conflicts with the Ninth Circuit's decision in *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir., July 6, 2001), is based on the Ninth Circuit's recent ruling in *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir., Sept. 13, 2001) (Appendix to the Brief in Opposition (Opp. App.)). *See* Opp. 11, 14-16.[1] The attempt fails.

Downing involved a photograph of several champion surfers that Abercrombie & Fitch bought and used, with the surfers' names, to illustrate an article in Abercrombie's subscription catalog, its "largest advertising vehicle" (Opp. App. 3). Distinguishing a case involving a documentary video on surfing (*Dora v. Frontline Video, Inc.*, 15 Cal.App. 4th 536 (1993)), the Ninth Circuit found that Abercrombie had used the photo "essentially as window-dressing" and held that Abercrombie's use of the photo was not protected by the First Amendment. Opp. App. 9-10. The court distinguished *Hoffman*:

> In contrast to the present case, where Abercrombie, itself, used Appellants' images in its catalog to promote its clothing, L.A. Magazine was unconnected to and received no consideration from the designer for the gown depicted in the article. Further, while L.A. Magazine merely referenced a shopping guide buried in the back of the magazine that provided stores and prices for the gown, Abercrombie placed the Appellants' photograph on the page immediately preceding the "Final Heat

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[1] Respondents say *Downing* was decided March 7, 2001 (Opp. iv, 11) – in which case it should have been discussed in the Petition, filed August 29, 2001. Respondents err. *Downing* was "Argued and Submitted" March 7, 2001, but was decided September 13, 2001. Opp. App. 1, 2. (Nor did Petitioners deem that this plainly distinguishable case, issued midway through the briefing process, warranted a Supplemental Brief.)

> Tees"[2] for sale. Based on these factors, we conclude that Abercrombie's use was much more commercial in nature and, therefore, not entitled to the full First Amendment protection accorded to L.A. Magazine's use of Hoffman's image. [Opp. App. 10 n. 2 (page citations omitted).]

Abercrombie's use of the surfers' photo thus was denied First Amendment protection because it was "much more commercial" than the use of Hoffman's photo by *L.A. Magazine*. The present case plainly is closer to *Hoffman* than to *Downing*. As the California Supreme Court held, "Saderup's portraits of The Three Stooges are expressive works and not an advertisement for or endorsement of a product," and hence "the present case does not concern commercial speech." Pet. A-10. *Downing* did. While Saderup's portraits were "not an advertisement for . . . a product," the surfers' photo as used in Abercrombie's catalog essentially was.

If this case had been litigated in the federal courts in California, then, the Ninth Circuit would have applied the rule of *Hoffman*, not the rule of *Downing* – the rule for noncommercial speech, not the rule for essentially commercial speech.[3] And Petitioners would have in the Ninth

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[2] These were T-shirts like those worn by the surfers in the photograph. Opp. App. 4.

[3] In averring that "[t]here is no uncertainty with respect to the right of publicity" (Opp. 10), Respondents see certainty where others see "rolls of the dice." *See* Ashlea Ebeling, "Publicity Shy," Forbes Magazine, Sept. 17, 2001, page 90:

> . . . The heirs of the Three Stooges don't want their mugs on T shirts. Their weapon? Right-of-publicity laws, which give people the right to control the use of their identity. The laws were meant to apply to commercial uses – that's why General Mills needs permission to put Michael Jordan on Wheaties boxes.
>
> But now celebrities and their heirs, flush with success against advertisers, are mounting a legal offensive against unauthorized nonadvertising uses

Circuit constitutional protection that they have been denied in California.

2. *Scope and Impact of the Decision.* Respondents strikingly confirm the scope of the California Supreme Court's decision and its potentially lethal impact not only on portrait art, but also on photography.

In the Petition we noted the threat to photography: "If Saderup's freehand drawing of the Stooges was not sufficiently "transformative" under the California court's test, it is hard to see how most photographs will fare any better with the court." Pet. 22. Respondents acknowledge and celebrate this result.[4] They see in this, not a danger to an important form of communication, visual art, and

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> of their images, such as on T shirts or in magazines. So far courts are sharply divided. The issue: Does the right of celebrities to control their images trump the First Amendment right of artists and media companies to free speech?
>
> In the latest big celebrity win, the California Supreme Court ruled in June against portrait artist Gary Saderup. He sold prints and T shirts bearing a charcoal image of the Stooges. Isn't this just an artist at work? Not to the court, which turned art critic and said Saderup's work is not "transformative," but merely a "literal, conventional" depiction that exploits the Stooges' fame. Yet a celebrated portrait artist like Andy Warhol might not face the same fate, the court suggested, saying his "ironic social comment" goes beyond commercial exploitation.
>
> . . . .
>
> Unless the Supreme Court clears up the battle, artistic portrayals of celebrities will remain rolls of the dice.

[4] "The fact that the images in this matter were not photographs but were charcoal drawings is irrelevant as the Petitioners point out at length." Opp. 4; *see also id.* n. 4 (Cal. Civil Code sec. 990(a) "specifically applies to photographs").

history, but "an express argument on behalf of the *paparazzi*." Opp. 4.

Respondents ask "why celebrities or celebrities' heirs should be less deserving of this property right than the *papparazzi* [*sic*]." Opp. 5. The principal answer is that *paparazzi* are photographers who create and author photographs,[5] just as Gary Saderup is a portrait artist who created the drawing at issue here. For Respondents, the photographers and artists who create the works are simply "another group of people who happen to come into the possession of a photograph or drawing of a celebrity." Opp. 5. The effect of the California Supreme Court's decision in transferring rights in photos from photographers and artists to celebrities and their heirs could hardly be made more clear.

In the Petition we also pointed out that "[t]he photo-stock-house industry, whose business is the sale of photos – the subjects of which often include celebrities – would seem at risk." Pet. 22-23 (footnote omitted). Respondents reply, "Why would that be a bad result?" Opp. 4.[6] They deride the idea that "anyone who can press a button on an automatic camera and take a photograph of any celebrity" (*id.*) may sell the photograph without the celebrity's consent, just as they deny that Gary Saderup's freehand drawing gives him that right. Opp. 6-7.[7]

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[5] Copyrightability of photographs and authorship in the photographer are recognized by copyright law. *See* 17 U.S.C. secs. 102(a)(5), 101; *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 60 (1884).

[6] Respondents do not say whether they also applaud the threat to the business of autograph dealers. *See* Pet. 23 n.28.

[7] Respondents argue that Petitioners, instead of stipulating to the facts, could have gone to trial on whether people bought Saderup's charcoal drawings because they "simply wanted a picture of the Three Stooges." Opp. 6; *see* also Opp. 24. Respondents, of course, equally could have gone to trial on the issue. Respondents bring in the fact that basketball player

One reason why garroting photo stock houses and other photo archives would be a bad result is that photographs are an invaluable part of our communications, culture, and consciousness, an irreplaceable record of our society and world.[8] This includes photos of celebrities.[9] If photos belong not to the photographers but to persons photographed, and to the heirs of those persons, then the celebrities and their heirs can control, edit, censor, and curtail this record. Even if the celebrities or their heirs do no more than demand royalties, the funds they exact must come out of the economic reward that copyright law assigns to the photographers in order to promote the creation of photographs.

Another reason for protecting photographs and photo archives rests on the realistic needs of the First Amendment. Although Respondents assert that Section 990's exemptions protect "most uses of a celebrity's image where there could be a First Amendment concern" (Opp. 8),[10] Respondents fail to confront the fact that even

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Shaquille O'Neal was an original co-plaintiff who "settled with Petitioners in the trial court." Opp. 6 n.8. They omit that this was a settlement in which O'Neal took nothing. *See* J.A. 116 ("It is a walk-away.")

[8] Section 990(i) defines a "photograph" to include "any video tape or live television transmission."

[9] Although we speak for convenience of "celebrities," the right of publicity as extended in this case may well apply to any person photographed if the photo has value. *See* Cal. Civil Code sec. 990(h) ("deceased personality" defined as "any natural person whose name, voice, signature, photograph, or likeness has commercial value at the time of his or her death"). *See KNB Ents. v. Matthews,* 78 Cal.App.4th 362, 393 n.12 (2000) ("under California law, the statutory right of publicity exists for celebrity and non-celebrity plaintiffs alike").

[10] Respondents' appreciation of First Amendment concerns excludes visual art. Respondents repeatedly ask "what the First Amendment interest is" in Saderup's drawings (Opp. 14, 18) while ignoring *Bery v. City of New York,* 97 F.3d 689 (2d Cir. 1996),

exempted uses, such as use of photos in a "magazine" or "newspaper" (Cal. Civil Code sec. 990(n)(1)), will be undermined if photo archives, stock houses, and other sources of photographs are made to dry up. Respondents do not deny that the statutory exemptions would not protect the photographer, stock house, archive, or other person who previously sells the photo without knowing the eventual use. *See* Pet. 22-23 & n.27. Yet the right to publish a celebrity's photograph in a magazine loses substance if the sources of such photos are constricted.[11] And given the enormous increase in the distribution of photos and other visual art through the Internet, the stakes involved in this push for ownership of photographs by celebrities and celebrities' heirs are great.[12]

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cert. denied, 520 U.S. 1251 (1997), and other cases that recognize First Amendment protection for visual art.

[11] For example, in *Downing* (Opp. App.), the plaintiff surfers apparently sued only Abercrombie & Fitch, which used their photo in its catalog. But Abercrombie had bought the photo from "surf photographer LeRoy Grannis." Opp. App. 4. Under the holding here of the California Supreme Court, Grannis apparently could also be sued and held liable for having sold the surfers' photos. The same might be true in *Hoffman* of whoever sold to *L.A. Magazine* the photo of Dustin Hoffman from "Tootsie."

[12] For an example of a photo archive, *see* N.Y. Times, Oct. 16, 2001 (nat'l ed.), p. A21 (full-page ad for "six million-image" New York Times Photo Archives, featuring "Joltin' Joe Photo Collection" consisting of five photographs of Joe DiMaggio published in the Times). The sale of these photos and others from the Times Photo Archives may be protected by provisions of New York law, notably that New York's right of publicity does not survive the celebrity's death. *E.g.*, *Smith v. Long Island Jewish-Hillside Medical Ctr.*, 118 A.D.2d 553, 554, 499 N.Y.S.2d 167, 168 (1986); J. Thomas McCarthy, The Rights of Publicity and Privacy (2d ed.), sec. 6:93 (2001) (McCarthy). In California, under the decision in this case, such an archive might well not be protected against claims by pictured celebrities or their heirs until 70 years after the celebrity's death.

3. *First Amendment Limitations.* Since Respondents view this case as involving the attempted "confiscation" by artists and photographers of a "property right belonging to celebrities and celebrities' heirs" (Opp. 4-5),[13] they see no need for the courts to balance the right of publicity against the First Amendment in any way beyond the test of artistic merit applied by the California Supreme Court. The First Amendment requires a better balance than that, a true and full weighing of the competing claims. This was done for privacy interests in last Term's *Bartnicki* decision.[14] It is done for speech that is plainly commercial.[15] It is done for copyright, by means of limitations built into copyright law (including the noncopyrightability of facts).[16] It is done for regulation of street sales of visual art.[17] And it was done for the right of publicity in *Cardtoons*,[18] where the court found itself required to "directly balance the magnitude of the speech restriction against the asserted governmental interest in protecting the intellectual property right."[19]

Respondents ask why this Court should apply a strict scrutiny test to the right of publicity. Opp. 21. An adequate

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[13] The claim of course begs the question, which is whether the asserted state law "property right" comports with the Constitution. *Compare Int'l News Service v. Associated Press*, 248 U.S. 215, 250 (1918) (Brandeis, J., dissenting).

[14] *Bartnicki v. Vopper*, ___ U.S. ___, 121 S.Ct. 1953 (2001).

[15] *E.g., Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n of New York*, 447 U.S. 557, 566 (1980); *Greater New Orleans Bortg, Ass'n v. United States*, 527 U.S. 173, 183 (1999).

[16] *See Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 559 (1985); *Feist v. Rural Telephone Service Co.*, 499 U.S. 340, 347-348 (1991).

[17] *Bery v. City of New York*, 97 F.3d 689, 697-99 (2d Cir. 1996), *cert. denied*, 520 U.S. 1251 (1997).

[18] *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10th Cir. 1996).

[19] *Id.* at 972.

answer would be that the speech is noncommercial and the right of publicity is content-based. *See, e.g., Reno v. ACLU*, 521 U.S. 844, 879 (1997). But if any balancing test is appropriate – as distinct from simple recognition that an artist's drawing, whether or not reproduced in copies, is protected speech – it would suffice to apply the "narrow tailoring" test for content-*neutral* regulations that was applied in *Bery*. 97 F.3d at 697-699; *see, e.g., Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989).[20] Such a balancing test should take into account, among other things, the social value of the publicity interest, especially when embalmed in a post mortem right extending 70 years after the celebrity's death;[21] the "commerciality" of the speech (*see Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 585 (1994)), especially whether it involves a use in advertising; the strength of the publicity and speech interests in a case involving, not use of celebrity's likeness in advertising or on any product, but sale of the likeness itself; the impact on constitutionally-protected visual art, photography in particular; and the impact on the federal interest in copyright when copyrighted works are held actionable under

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[20] *Cf.* Neil Weinstock Netanel, *Locating Copyright Within the First Amendment Skein*, 54 Stan.L.Rev. 1 (2001); *id.* at 39 ("Where property rights are not in land, but in information, expression, or communicative capacity, they are more properly characterized as speech regulations"); *id.* at 54 ("Copyright Falls Within a Sub-Category of Content-Neutral Regulation Requiring Rigorous Scrutiny Under *Turner*").

[21] Respondents say "[a]ny argument that intellectual property rights should die with the author would apply to the law of copyright, patent, and even trademark as well as the right of publicity." Opp. 23 n.26. But all intellectual property rights are not created equal (*see, e.g.*, the different terms for copyright and patent); there is no reason why they should not be treated differently. *See* Restatement , *supra*, sec. 46, Comment h ("the dignitary and proprietary interests that support the recognition of a right of publicity become substantially attenuated after death"); *accord, id.* sec. 47, Comment d.

state law and made subject to heavy damages (including punitives).[22] Balancing required by the First Amendment assuredly is not adequately provided by the rational basis test. Pet. A-17.[23]

With or without the framework supplied by an appropriate balancing test, the Court should proceed to more categorical ways of applying the First Amendment to limit the right of publicity. These would include:

(1) As an article cited by Respondents proposes, courts and legislatures, "[i]n reconfiguring the right of publicity," should "inject a requirement that the celebrity prove likelihood of consumer confusion as to whether the celebrity plaintiff endorsed the product, service, or business being promoted in the defendant's commercial use." Arlen W. Langvardt, *The Troubling Implications of a Right of Publicity "Wheel" Spun Out of Control*, 45 U.Kan.L.Rev. 329, 443 (1997).

(2) The right of publicity at least should be rolled back to its original "commercial" uses, consisting of uses in advertising or *on* products, and stopped short of the present claim that the likeness *is* the product ("the product

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[22] In denying the possibility of copyright preemption, Respondents cite *Brown v. Ames*, 201 F.3d 654 (5th Cir. 2000), as having "rejected such a contention." Opp. 11 n.14. The court in *Brown*, in upholding a claim by musicians and songwriters for unauthorized use of their names and likenesses in marketing their recorded performances, stipulated that it was rejecting the defense of conflict preemption only because the defendants lacked authority to market the recordings, "whether through copyright or the public domain." *Id.* at 660; see also 661.

[23] This Court's *Zacchini* decision (*Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977)), relied on by Respondents (Opp. 19-20), is more accurately called a "right of performance" than a "right of publicity" case. *See* Douglas G. Baird, Note, *Human Cannonballs and the First Amendment*, 30 Stan.L.Rev. 1185, 1186 n.7 (1978); Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 Cal.L.Rev. 127, 209 n.395 (1993).

consists of the likeness," Pet. A-9 n.6).[24] This approach would recognize that, although visual art by its nature generally involves tangible media, this fact does not convert artistic expression into a product; what is being sold is speech. It also would avoid the constitutional problem of a property right conferred by state law in the uncopyrightable fact-of-nature that is one's appearance. *See* Pet. 25 n.34.

(3) The Court should approve the rule of the Ninth Circuit in *Hoffman* that when the speech is not commercial, its use of a celebrity's name or likeness cannot support liability to a public figure without proof of actual malice. *See* Pet. App. F-10.

(4) Leaving other possible limits for the future, the Court should take a first step in cabining the right of publicity by adopting as a constitutional requirement the view of the thirty-three States[25] that recognize no post mortem right of publicity.[26]

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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[24] Respondents mask their claim in the traditional trappings. They say Section 990 does no more than require celebrities' heirs' permission to use their ancestors' likeness "on an advertisement or on products" and they speak of placing the celebrity's photo "on merchandise." Opp. 10, 4.

[25] *See* McCarthy, *supra*, sec. 9:19 (17 states recognize postmortem right of publicity).

[26] This would be appropriate not only because publicity interests become "substantially attenuated after death" (Restatement, *supra*, sec. 46, Comment h), but also because, as Respondents stress (Opp. 18-19), the right of publicity arose out of the right of privacy. The right of privacy traditionally has "no postmortem duration." McCarthy, *supra*, sec. 9:1.